

REMARKS

Reconsideration of the present application is respectfully requested.

Claims 11 and 14 have been amended to correct minor grammatical errors and not in response to the Examiner's outstanding rejection of these claims or in view of any of the art of record.

The Examiner has checked Box (a)3) under item 12 on the PTOL-326 accompanying the present office action, thereby indicating that a certified copy of the JP priority document was received from the International Bureau. However, this application is not a National Stage application. Therefore, it is respectfully requested that the Examiner issue a corrected form PTOL-326 with Box (a)(1) checked under item 12.

Claims 1-16 have been rejected under 35 U.S.C. 102 (b) as being anticipated by Oshida, et al (U.S. Patent No. 6,434,482 (hereinafter "Oshida")). This rejection is respectfully traversed.

The vehicle navigation system of the present invention includes a data storage means 4 that stores data, such as names and categories of points of interest, as well as data on supplemental items such as facilities and services available at the points of interest. Exemplary supplemental items are shown in FIG. 6 for an exemplary category identified as "convenience stores" and may include, for example, a restroom, an ATM, liquor sales, cigarette sales, a parcel delivery service, a payment service, a ticketing service and/or a mailbox. Other examples are shown in FIG. 7 for an exemplary category identified as "banks." Because the data storage means stores these supplemental items, a user can search, as shown in FIGs. 9 and 10, for a point of interest, and more specifically for a point of interest that provides a specific facility or service.

During operation of the vehicle navigation system of the present invention, control means 2 in the navigation system searches for a point of interest that provides a facility or a service specified by a user in the data stored by the data storage means 4. The control means 2 searches for an exit from which the searched point of interest is accessible, and displays the exit on a display device 7. With this configuration, and as shown in FIGs. 9 and 10, the user can search for a point of interest based on facilities and services that the user is actually looking for, and can obtain information on an exit from which the searched point of interest is accessible.

Oshida describes a vehicle navigation system that includes data storage means 11 containing facility (or “point of interest” in terms of the present application) information. A control means 18 included in the vehicle navigation system reads the facility information from the data storage means 11 and displays it by superimposing it on the map image on the display screen as shown in FIG. 1(a). The facility information only includes a category of the facility and a distance between a nearest exit and the facility.

The data storage means 11 in Oshida does not store *inter alia* supplemental items regarding facilities and services available at the points of interest as recited in claims 1, 11 and 14 of the present invention. As a result, a user cannot retrieve detailed information on a point of interest, much less information on additional services available at the point of interest. In other words, while a user may be able to search for and identify restaurants, the user cannot search for a restaurant based on facilities and/or services desired by the user, such as an ATM or liquor sales.

In view of the above, the Examiner has failed to establish a *prima facie* case of anticipation, as all the claimed features are not disclosed in the Oshida. Therefore, it is respectfully requested that the Examiner’s rejection under 35 U.S.C. 102(b) of claims 1, 11 and 14, as well as all claims dependent thereon, be withdrawn.

It is noted that the Examiner asserts in numbered paragraph 5 on page 5 of the Office Action that “means plus function limitations are met by structures which are equivalent to the corresponding structures recited in the specification.” Further, the Examiner supports this assertion by citing *In re Ruskin* as implicitly modified by *In re Donaldson* (citations omitted), as noted in MPEP 2114 (8th Edition, Rev. 1, Feb. 2003).

However, the Examiner has provided improper support for the above assertion and has failed to fully consider the issue of how much weight to afford functional portions of means-plus-function limitations in view of the case law provided for just that purpose in MPEP 2181-2186 (see reference to these sections at the beginning of 2114). The Examiner should note that there is ample precedent to establish that functional limitations should be afforded patentable weight. (See, e.g., *In re Land*, 368 F.2d 866, 151 USPQ 621 (C.C.P.A. 1966).)

Pursuant to the examination guidelines provided in, for example, MPEP 2182-2183, the application of a prior art reference to a means- or step-plus-function limitation requires that a prior art element perform the identical function specified in the claim. The Examiner must show that the prior art structure or step is the same as or equivalent to the structure, material or acts described in the specification and identified as corresponding to the claimed means- or step-plus-function only if the prior art reference teaches identity of function to that specified in the claim. (See MPEP 2182, second complete paragraph in which the *In re Donaldson* decision is discussed in more detail.) In examining a means- or step-plus-function limitation, the Examiner should provide an explanation as to why the prior art element is an equivalent if the prior art element (A) performs the function specified in the claim, (B) is not excluded by any explicit definition provided in the specification for an equivalent, and (C) is an equivalent of the means- (or step-) plus-function limitation. (Emphasis added; see beginning of MPEP 2183.)

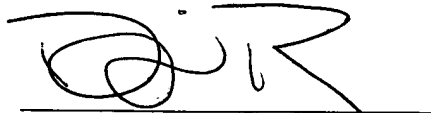
In view of the above remarks, it is clear that the Examiner has used the incorrect standard in his above noted assertion. Therefore, it is respectfully requested that examination of the present application, and specifically examination of those pending claims including means-plus-function limitations, proceed in view of the above noted appropriate standard of examination for means-plus-function claims.

Claims 17-19 have been added to more specifically recite that the supplemental items comprise facilities and services available at one or more of gas stations, restaurants, convenience stores and banks. In addition, claims 20-22 more specifically recite the types of facilities and services that may be included in the supplemental items stored in the data storage means recited in claims 1, 11 and 14, respectively. Support for these claims may be found, for example, in FIGs. 6 and 7 and in corresponding portions of the specification.

In view of the foregoing, the Applicants respectfully submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Please charge any unforeseen fees that may be due to Deposit Account No. 50-1147.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'DGP', is written over a horizontal line.

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